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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,230	08/08/2001	Ruth E. Rosenholtz	110269	9875

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EXAMINER

ZHOU, TING

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 04/02/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,230

Applicant(s)

ROSENHOLTZ ET AL.

Examiner

Ting Zhou

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2, 3</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 23-25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 23-25 are written in the form of a preamble made to depend on another claim. The stated preamble is not given patentable weight as it fails to breathe life, meaning, and vitality into the claims. As such, the claims fail to further limit the subject matter of the claim(s) upon which they depend. See MPEP §§ 608.01(n) and 2111.02.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hahn et al. U.S. Patent 5,751,287.

Referring to claims 1 and 12, Hahn et al. teach a method and system of displaying a document comprising a display device and controller (computer system including display screen

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and GUI) (column 4, lines 58-67 and column 5, lines 1-7) that displays a thumbnail (drawers of the filing cabinet) having at least one first selectable element (file folders within the drawers), the thumbnail as a whole being selectable (the drawers can be selected, or opened, by the user) and having an original document as a first associated destination (all the documents contained inside the drawer), and the at least one first selectable element having, as a second associated destination, one of a portion of the original document, smaller than the original document as a whole (a file within the drawer contains a portion of the documents, smaller than the original bundled documents inside the drawer) and a document other than the original document (documents in the other file folders or drawers can be selected); receives a selection of one of the thumbnail as a whole and the at least one first selectable element; and accesses one of the first associated destination and the second associated destination, based on the selection (receiving user input of selection of a drawer and file folder within the drawer and retrieving the files and documents according to user selection), as recited in column 4, lines 27-67 and column 8, lines 28-58. This is further shown in Figure 12A.

Referring to claims 2 and 13, Hahn et al. teach the portion of the original document being a document portion not uniquely associated with any selectable element provided in the original document (any document associated with any drawer, or selectable element, can be selected and displayed to the user) (column 9, lines 54-58 and further shown in Figure 12A).

Referring to claims 3 and 14, teach the portion of the original document being an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document (any arbitrary document in any of the folders of the drawers can be selected by the user) (column 9, lines 54-58 and further shown in Figure 12A).

Referring to claims 4 and 15, Hahn et al. teach a method and system of displaying a document comprising a display device and controller (computer system including display screen and GUI) (column 4, lines 58-67 and column 5, lines 1-7) that displays a thumbnail associated with an original document (drawers of the filing cabinet associated with the bundle of documents, or original document, contained inside) and having at least one first selectable element (file folders within the drawers), each at least one first selectable element having, as an associated destination, one of an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document (any document in any of the folders of the drawers can be selected by the user) and a document other than the original document (any document in any of the drawers can be selected by the user); receives a selection of one of the at least one first selectable element; and directly accesses the associated destination based on the selection (receiving user input of selection of a drawer and file folder within the drawer and retrieving the files and documents according to user selection), as recited in column 4, lines 27-67, column 8, lines 28-58 and column 9, lines 54-58. This is further shown in Figure 12A.

Referring to claims 5 and 16, Hahn et al. teach the thumbnail being an enhanced thumbnail (as shown in Figure 5) having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document. It is noted that “enhanced thumbnails” according to the specification of the applicant’s invention “increase user efficiency by allowing the user to grasp document content without having to view the entire document” (page 6, paragraph 0033 of the Specification). The thumbnail taught by Hahn et al. includes an icon and text name field, aiding users in quickly identifying the drawer, as recited in

column 5, lines 52-56 and column 6, lines 25-27. Therefore, the users can grasp the content of the documents contained inside the drawer without having to view the entire document.

Referring to claims 6, 10, 17 and 21, Hahn et al. teach the at least one element with a modified appearance is the at least one first selectable element (the enhanced thumbnails such as the drawers shown in Figure 5 can be opened, or selected, by the user) (column 5, lines 52-56 and column 6, lines 25-27).

Referring to claims 7 and 18, Hahn et al. teach the document other than the original document being accessible by selection of a third selectable element provided in the original document (the system contains many drawers, each of which can be selected by the user), as shown in Figures 5 and 12A.

Referring to claims 8, 11, 19 and 22, Hahn et al. teach the at least one first selectable element being a visibly discrete element, as shown by the separate and discrete drawers shown in Figures 5 and 12A.

Referring to claims 9 and 20, Hahn et al. teach a method and system of displaying a document comprising a display device and a controller (computer system including display screen and GUI) (column 4, lines 58-67 and column 5, lines 1-7) that displays an enhanced thumbnail associated with an original document (drawers of the filing cabinet associated with the bundle of documents, or original document, contained inside and having at least one first selectable element (file folders within the drawers), the enhanced thumbnail having at least one element with a modified appearance relative to an appearance of a corresponding element in the original document (it is noted that “enhanced thumbnails” according to the specification of the applicant’s invention “increase user efficiency by allowing the user to grasp document content

without having to view the entire document”, as disclosed on page 6, paragraph 0033 of the Specification. The thumbnail taught by Hahn et al. includes an icon and text name field, aiding users in quickly identifying the drawer, as recited in column 5, lines 52-56 and column 6, lines 25-27, and further shown in Figure 5. Therefore, the users can grasp the content of the documents contained inside the drawer without having to view the entire document), each at least one first selectable element having, as an associated destination, a portion of the original document, smaller than the original document (a file within the drawer contains a portion of the documents, smaller than the original bundled documents inside the drawer) and not uniquely associated with any selectable element provided in the original document (any document associated with any drawer, or selectable element, can be selected and displayed to the user) (column 9, lines 54-58 and further shown in Figure 12A); receives a selection of one of the at least one first selectable element; and directly accesses the associated destination based on the selection (receiving user input of selection of a drawer and file folder within the drawer and retrieving the files and documents according to user selection), as recited in column 4, lines 27-67 and column 8, lines 28-58. This is further shown in Figure 12A.

Referring to claim 23, Hahn et al. teach an information storage medium on which is recorded a program for implementing the steps of claim 1 (column 5, lines 8-18).

Referring to claim 24, Hahn et al. teach an information storage medium on which is recorded a program for implementing the steps of claim 4 (column 5, lines 8-18).

Referring to claim 25, Hahn et al. teach an information storage medium on which is recorded a program for implementing the steps of claim 9 (column 5, lines 8-18).

3. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar methods for document manipulation via the use of thumbnails.

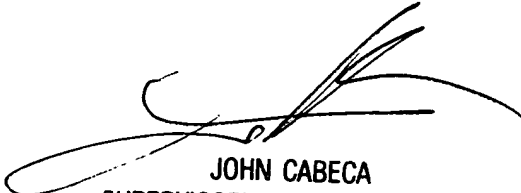
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703) 305-0328. The examiner can normally be reached on Monday - Friday 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 23, 2004


JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2173

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